APPENDIX A

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

96-1514, -1515
(Interference No. 102,598)

GILBERT P. HYATT,
Appellant,

v.

GARY W. BOONE,
Cross-Appellant.

DECIDED: June 17, 1998

Before NEWMAN, MICHEL, and PLAGER, *Circuit Judges.*

NEWMAN, *Circuit Judge.*

The parties to Patent Interference No. 102,598 are Gilbert P. Hyatt, inventor of United States Patent No. 4,942,516 entitled "Single Chip Integrated Circuit Computer Archiecture" (the '516 patent), and Gary W. Boone, inventor of patent application Serial No. 07/473,541 entitled "Variable Function Programmed Systems" (the '541 application). Mr. Hyatt appeals the decision of the Board of Patent Appeals and Interferences, entering judgment against him and cancelling the relevant claims of his '516 patent. Mr. Boone cross-appeals the Board's entry of

judgment against him. We affirm the Board's decision,[1] with modification of the judgment to declare Boone the prevailing party in the interference.

DISCUSSION

Determination of priority of invention invokes a complex body of procedural and substantive law, applied in the first instance in administrative proceedings in accordance with 35 U.S.C. § 135(a) ("The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability.") The interference proceeding implements the principle of United States law that the right to a patent derives from priority of invention, not priority of patent application filing.

The general rule is that the first person to conceive the invention is the first inventor, *see* Irving Kayton, *The United States Patent as a Legal Instrument, in* 1 *Patent Practice* 2-1, 2-39 (Irving Kayton and Karyl S. Kayton eds., 4th ed. 1989) ("The earliest possible date of invention, therefore, is the date of conception."), provided that when the first to conceive the invention is the last to reduce it to practice, the person who was first to conceive must have exercised reasonable diligence to his own actual or constructive reduction to practice, "from a time prior to conception by the other." 35 U.S.C. § 102(g). *See* Charles L. Gholz, *Interference Practice, in* 6 *Patent Practice, supra,* 24-1, 24-6(c); *Paulik v. Rizkalla,* 760 F.2d 1270, 1272, 226 USPQ 224, 225 (Fed. Cir. 1985) (in banc). Thus, during an interference proceeding evidence may be presented of conception, reduction to practice, and diligence, as appropriate to the positions of the parties, *see id.*; *see generally* Gholz, *supra,* at 24-1, or a party

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[1] *Hyatt v. Boone,* Patent Interference No. 102,598 (Bd. Pat. App. & Inter. Sept. 19, 1995) (Decision after Final Hearing); *Hyatt v. Boone,* Patent Interference No. 102,598 (Bd. Pat. App. & Inter. May 10, 1996) (Decision on Reconsideration).

may rely on the patent document to establish the facts of priority of invention. *See* Gholz, *supra,* at 24-45.

The contested invention is a computer formed on a single integrated circuit chip, having specified circuits and functions. The sole count of the interference is:

> A computer on a chip comprising:
>
> an integrated circuit chip having a computer implemented thereon;
>
> an integrated circuit main memory storing computer instructions, wherein said integrated circuit main memory is included on said integrated circuit chip;
>
> an integrated circuit operand memory storing operands, wherein said integrated circuit operand memory is included on said integrated circuit chip; and
>
> an integrated circuit processing circuit processing the operands stored by said integrated circuit operand memory in response to the instructions stored in said integrated circuit main memory, wherein said processing circuit is included on said integrated circuit chip.

The interference contest was initiated by Boone after Hyatt's '516 patent issued. Boone followed the procedure of copying certain of Hyatt's patent claims into his pending application and asking the patent examiner to "declare" the interference. 37 C.F.R. § 1.607 (1990). The examiner so acted. *See* 37 C.F.R. § 1.611 (1990).

Both parties claimed the benefit of earlier-filed patent applications, relying on the earlier applications for constructive reduction to practice of the subject matter of the count. *See* 37 C.F.R. § 1.626 (1990). Conception is not at issue in this appeal, and neither party presented evidence of actual reduction to practice. At the Motions stage from which the Board's decision evolved, the only

issue was each party's entitlement to certain asserted dates of constructive reduction to practice.

Boone was granted an effective filing date, through a chain of nine prior applications, of an application filed on July 19, 1971. Hyatt was granted an effective filing date, through a chain of four prior applications, of an application filed on December 14, 1977. The Board denied Hyatt the benefit of the filing date of his December 28, 1970 application No. 05/101,881 (the '881 application) as to the subject matter of the count. Hyatt disputes the denial of the '881 application filing date, and also challenges the date awarded to Boone.

I

HYATT'S '881 APPLICATION

The filing of a patent application serves as conception and constructive reduction to practice of the subject matter described in the application. *Yasuko Kawai v. Metlesics*, 480 F.2d 880, 885, 178 USPQ 158, 162 (CCPA 1973) ("[T]he act of filing the United States application has the legal effect of being, constructively at least, a simultaneous conception and reduction to practice of the invention."); *see Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986) ("constructive reduction to practice occurs when a patent application on the claimed invention is filed"); *In re Glass*, 492 F.2d 1228, 1232, 181 USPQ 31, 34 (CCPA 1974). There is no need for proof or corroboration of the subject matter that is included in the application unless a date earlier than the filing date is sought to be established. *Yasuko Kawai*, 480 F.2d at 886, 178 USPQ at 163 ("the written specification in the application is the evidence proving the invention of that which is reduced to practice"). Thus the inventor need not provide evidence of either conception or actual reduction to practice when relying on the content of the patent application.

However, the patent application must comply with the legal requirements for support of the interference count. When a party to an interference seeks the benefit of an earlier-filed United States patent application, the earlier application must meet the requirements of 35 U.S.C. § 120 [2] and 35 U.S.C. § 112 ¶ 1 [3] for the subject matter of the count. The earlier application must contain a written description of the subject matter of the interference count, and must meet the enablement requirement. *Fiers v. Revel*, 984 F.2d 1164, 1170, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993) (section 112 paragraph 1 must be met by the earlier application). The Board found that Hyatt's '881 application did not provide the requisite written description; the Board did not decide the question of enablement.

A

We review the Board's findings on the standard of clear error, for compliance with the written description requirement is a question of fact. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). Hyatt relies as written description on the text of claim 40 as that claim was originally filed in the '881 application, viewed with the entire specification.

The claims as filed are part of the specification, and may provide or contribute to compliance with § 112.

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[2] **35 U.S.C. § 120. Benefit of earlier filing date in the United States.**

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States . . . shall have the same effect, as to such invention, as though filed on the date of the prior application . . . .

[3] **35 U.S.C. § 112 ¶ 1.**

[The application must contain] a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . . .

See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 938, 15 USPQ2d 1321, 1326 (Fed. Cir. 1990) (the original claims are part of the patent specification); *In re Benno*, 768 F.2d 1340, 1346, 226 USPQ 683, 686-87 (Fed. Cir. 1985); *In re Frey*, 166 F.2d 572, 575, 77 USPQ 116, 119 (CCPA 1948). Hyatt's original claim 40 is for a data processing system implemented on a single integrated circuit chip, as follows:

> 40. An electronic data processing system including read only memory means, alterable memory means and program means, said system being implemented on a single integrated circuit chip.

There is no other mention in the '881 specification of a single integrated circuit chip, although other electronic data systems are extensively described.

Hyatt's position is that the text of claim 40 describes the subject matter of the interference count, in that the "read only memory means" of claim 40 is the same as the "integrated circuit main memory storing computer instructions" of the count, the "alterable memory means" of claim 40 is the same as the "integrated circuit operand memory storing operands" of the count, and the "program means" of claim 40 is the same as the "integrated circuit processing circuit" of the count. Hyatt states that the '881 specification contains detailed descriptions of various computer circuits, which supplement the text of claim 40 in that the specification describes a computer made up of numerous integrated circuits mounted on multiple printed circuit boards and comprising a "physically distributed, operatively dispersed system."

The Board held that the written description must be sufficient, when the entire specification is considered, that the "necessary and only reasonable construction" that would be given it by a person skilled in the art is one that clearly supports each positive limitation in the count. The Board found that the term "program means" in claim 40 is used to describe only computer instructions or as a

modifier of "program control means," and does not describe or require the interpretation that the program processes the operands stored by the alterable memory in accordance with instructions stored in the read only memory, as is required by the count. The Board also found that the "read only memory means" of claim 40 need not be a main memory storing computer instructions, and that the "alterable memory means" of claim 40 need not be an operand memory storing operands. Thus the Board found that original claim 40 could be read as describing subject matter other than that of the count, and thus did not establish that Hyatt was in possession of the invention of the count. The Board found that the parts of the written description that are lacking from claim 40 are not provided elsewhere in the '881 specification, whose systems and circuitry neither describe nor suggest a computer on a single chip. The Board concluded that "[w]hile two memories and a computer program may generally constitute a data processing system of some sort, they do not describe the invention set forth by the count."

Rejecting Hyatt's argument, supported by testimony of witnesses, that the absent description would have been apparent to persons of skill in this field, the Board stated that "if 'program means' can be a circuit (processor) that responds to a program as indicated by [Hyatt's] witnesses, it is at least as likely that it can be a memory that merely stores a program without processing operands." The Board held that witnesses can not "establish facts which the disclosure itself should provide," citing *In re Smyth*, 189 F.2d 982, 990, 90 USPQ 106, 112 (CCPA 1951). Hyatt challenges these findings and conclusions, as well as the Board's legal standard for determining compliance with the written description requirement.

B

For an earlier-filed application to serve as constructive reduction to practice of the subject matter of an interference count, the applicant must describe the subject matter of the count in terms that establish that he was in

possession of the later-claimed invention, including all of the elements and limitations presented in the count, at the time of the earlier filing. Although Hyatt is correct that known details need not be included in a patent specification, *see In re Eltgroth*, 419 F.2d 918, 921, 164 USPQ 221, 223 (CCPA 1970) ("This court has often observed that minutiae of descriptions or procedures perfectly obvious to one of ordinary skill in the art yet unfamiliar to laymen need not be set forth."), when an explicit limitation in an interference count is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation. As discussed in *Martin v. Mayer*, 823 F.2d 500, 505, 3 USPQ2d 1333, 1337 (Fed. Cir. 1987), "It is 'not a question of whether one skilled in the art *might* be able to construct the patentee's device from the teachings of the disclosure . . . . Rather, it is a question whether the application necessarily discloses that particular device.'" (quoting *Jepson v. Coleman*, 314 F.2d 533, 536, 136 USPQ 647, 649-50 (CCPA 1963)). *See Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). It is insufficient as written description, for purposes of establishing priority of invention, to provide a specification that does not unambiguously described all limitations of the count. *See, e.g., Wagoner v. Barger*, 463 F.2d 1377, 1380, 175 USPQ2d 85, 86-87 (CCPA 1972); *Dyer v. Field*, 386 F.2d 466, 156 USPQ 85 (CCPA 1967); *Bocciarelli v. Huffman*, 232 F.2d 647, 109 USPQ 385 (CCPA 1956).

Hyatt and Boone presented conflicting views of the knowledge of a person of ordinary skill in the field of the invention at the time the '881 patent application was filed, and disputed whether such a person would have understood the text of Hyatt's original claim 40 as describing all of the limitations of the count. Hyatt's witnesses testified that a person of skill in this field would have known

that the program means processes the operands in accordance with the read-only memory instructions, and would have readily understood that the program means, read only memory means, and alterable memory means cooperate in the way stated in the count. The Board criticized this testimony on the ground that although Hyatt's witnesses stated that it was well known that a data processing system must include a processing circuit of some sort, they did not address "whether a data processing system must necessarily include the specific processing circuit required by the count." We have not been shown clear error in the Board's findings as to the content of the written description, and the conclusion that the missing subject matter was not known details, but significant claim limitations; the missing subject matter was not shown to be part of the prior art that would be understood as part of the description of the subject matter of the count.

Hyatt states that even if the Board's findings are not clearly erroneous as to the content of the written description, the Board applied an incorrect legal standard in requiring that the specification "necessarily" describe the entire subject matter of the count. Hyatt states that a separate body of precedent, typified by *Vas-Cath Inc v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991), states a different and better standard. In *Vas-Cath* the court stated that the applicant must "convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." *Id.* at 1563-64, 19 USPQ2d at 1117. Other cases have used the same words in assessing the adequacy of the written description. *See, e.g., Fujikawa v. Wattanasin*, 93 F.3d 1559, 1570, 39 USPQ2d 1895, 1904 (Fed. Cir. 1996) ("the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question"); *Fiers v. Revel*, 984 F.2d at 1170, 25 USPQ2d at 1606 (same);

In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983) (same). Hyatt states that he readily met this requirement, in that original claim 40 of his '881 application reasonably conveyed to persons of skill in this field that he possessed the invention of the count.

Hyatt argues that "reasonably conveys to the artisan" is a less rigorous and more reasonable measure of the written description requirement than the "necessary and only reasonable construction" standard that the Board applied. Precedent has used both phrases, as well as others. See, *e.g.*, *In re Wertheim*, 646 F.2d 527, 538-39, 209 USPQ 554, 565 (CCPA 1981) (the disclosure relied on must "constitute[] a full, clear, concise and exact description . . . of the invention claimed"). We do not view these various expressions as setting divergent standards for compliance with § 112. In all cases, the purpose of the description requirement is "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him." *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978). Thus, the written description must include all of the limitations of the interference count, or the applicant must show that any absent text is necessarily comprehended in the description provided and would have been so understood at the time the patent application was filed.

The Board did not clearly err in finding that Hyatt did not establish in the '881 application's written description that he possessed the entire subject matter of the count. This finding comports with the criterion not only of whether the description conveyed to the artisan the specific subject matter of the count, but also of whether the applicant established that this was the necessary construction of that description. The written description must include the limitations of the count with sufficient clarity and specificity that "persons of ordinary skill in the art

will recognize from the disclosure that appellants invented processes including those limitations," *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). The denial to Hyatt of benefit of the '881 application date as constructive reduction to practice of the interference count is affirmed.

II

BOONE'S '565 APPLICATION

Hyatt objected to the action of the administrative patent judge in according Boone the benefit of the July 19, 1971 filing date of application Serial No. 163,565 (the '565 application), the first of ten applications culminating in the '541 application in interference. Hyatt's objection is that at least two of these ten applications are invalid continuation applications, thus breaking the chain of priority. Hyatt states that Boone's second and eighth applications, both of which were filed under the "streamlined" procedures of 37 C.F.R. § 1.60 (Rule 60) with photocopies of the prior specification and oath, contained amended claims and thus could not have been filed under Rule 60, but required a new oath. Boone concedes the facts of these filings, but argues that these are not flaws, or not flaws fatal to his entitlement to trace priority through the chain.

Rule 60, at the time of Boone's first challenged continuation application in 1973, was as follows:

> **37 C.F.R. § 1.60 [1973].** A continuation or divisional application . . . which discloses and claims only subject matter disclosed in a prior application may be filed as a separate application before the patenting or abandonment of or termination of proceedings on the prior application. If the application papers comprise a copy of the prior application as filed, signing and execution by the applicant may be omitted . . . . Only amendments reducing the num-

> ber of claims or adding a reference to the prior application (§ 1.78(a)) will be entered before calculating the filing fee and granting of the filing date.

By 1987, when Boone's eighth continuation was filed, Rule 60 had been elaborated as follows:

> **37 C.F.R. § 1.60(b) [1987].** An applicant may omit signing of the oath or declaration in a continuation or divisional application if . . . (2) applicant files a true copy of the prior complete application as filed including the specification (including claims), drawings, oath or declaration showing the signature or an indication it was signed, and any amendments referred to in the oath or declaration filed to complete the prior application . . . . Only amendments reducing the number of claims or adding a reference to the prior application (§ 1.78(a)) will be entered before calculating the filing fee and granting of the filing date.

From the text of these provisions, it is not clear whether any technical violation of Rule 60 actually occurred with the presentation of amended claims. The administrative patent judge found none. No objection to compliance with Rule 60 was raised by the PTO at the time these applications were filed and prosecuted. The issue here raised is not one of substantive continuity of disclosure, but solely of whether a photocopy of the prior oath, instead of a new oath, was acceptable for filing, when it was in fact accepted for filing. Any technical deficiency in meeting the formal requirements of Rule 60 must be viewed in light of the agency's acceptance of the applications as in compliance with the Rule. Regularity of routine administrative procedures is presumed, and departure therefrom, should such have occurred, is not grounds of collateral attack. Courts should not readily intervene in the day-to-day operations of an administrative agency, especially when the agency practice is in straightforward implementation of the statute. *Cf. Vermont Yankee Nu-*

clear Power Corp. v. Natural Resources Defense Council, Inc., 435 U.S. 519 (1978) ("[T]his Court has for more than four decades emphasized that the formulation of procedures was basically to be left within the discretion of the agencies to which Congress had confided the responsibility for substantive judgments."); *Federal Power Comm'n v. Transcontinental Gas Pipe Line Corp.*, 423 U.S. 326, 333-34 (1976) (" 'The Court, it is true, has power 'to affirm, modify, or set aside' the order of the Commission 'in whole or in part.' . . . But that authority is not power to exercise an essentially administrative function.' ") (quoting *Federal Power Comm'n v. Idaho Power Co.*, 344 U.S. 17, 21 (1952)). We also take note, as held in *Weil v. Fritz*, 572 F.2d 856, 863, 196 USPQ 600, 606 (CCPA 1978), that the "applicant's oath is not a requirement of § 112, first paragraph, but of 35 U.S.C. § 115; therefore, the sufficiency of [the prior] oath is not material under § 120."

We discern no reversible error in the grant to Boone of the benefit of his chain of filings.

III

BOONE'S CROSS-APPEAL

The Board declined to enter judgment in favor of Boone, and entered judgment against Boone based on his request that his application be converted into a Statutory Invention Registration (SIR). Boone appeals the Board's refusal to rule on the patentability of his claims, which had been rejected on the ground of double patenting, and states that the Board erred in its refusal to enter judgment that the issue of priority was decided in his favor.

At the hearing before the Board Boone renewed his request that the '541 application be converted into a Statutory Invention Registration in accordance with 35 U.S.C. § 157. The SIR permits an inventor to forego the grant of a patent while preserving the opportunity to contest

priority through interference proceedings. The statute provides:

> **35 U.S.C. § 157. Statutory invention registration**
>
> (a) Notwithstanding any other provision of this title, the Commissioner is authorized to publish a statutory invention registration containing the specification and drawings of a regularly filed application for a patent without examination if the applicant—
>
> (1) meets the requirements of section 112 of this title;
>
> (2) has complied with the requirements for printing, as set forth in regulations of the Commissioner;
>
> (3) waives the right to receive a patent on the invention within such period as may be prescribed by the Commissioner; and
>
> (4) pays application, publication, and other processing fees established by the Commissioner.
>
> * * * *
>
> (c) A statutory invention registration published pursuant to this section shall have all of the attributes specified for patents in this title except those specified in section 183 and sections 271 through 289 of this title. A statutory invention registration shall not have any of the attributes specified for patents in any other provision of law other than this title. . . . The invention with respect to which a statutory invention certificate is published is not a patented invention for purposes of section 292 of this title.

The inventor of the SIR has "the same rights that a patent provides to prevent others from patenting the invention." *Section-by-Section Analysis: Patent Law Amendments of 1984*, 130 Cong. Rec. H10525 (Oct. 1, 1984), *reprinted in* 1984 U.S.C.C.A.N. 5827, 5828. The

inventor preserves the ability to protect the right to practice his own prior invention as against any later inventor, while foregoing the right to exclude others even if he is the prior inventor. Thus the SIR affords an inventor the possibility of securing the defensive aspects of a patent by obtaining the right to contest priority, while agreeing to publish the technology, thereby benefitting the public. *Id.*

Boone moved for permission to convert his '541 application to a SIR, after Boone had initiated this interference with Hyatt and Boone's '541 application was rejected, on Hyatt's motion, on the ground of double patenting. Boone argues that the conversion of the '541 application to the SIR removed the only obstacle to patentability raised by the double patenting rejection, *i.e.* that of extension of effective patent life, because the SIR—since it is not an enforceable patent—would not effectively extend the patentee's right to exclude. Boone argues that he is entitled to a decision as to patentabiilty although he will not obtain a patent.

The Board did not err in declining to rule on this issue in view of Boone's requested conversion to a SIR. Although Boone states that he is free to withdraw the SIR application at any time until the PTO has given notice of the intent to publish it, the intervening event of the interference proceeding has eliminated this option. Although administrative flexibiilty to accommodate changed circumstances or interests is a benefit of agency practice, there is rarely room for a complete change in position after the contrary position had achieved its purpose in a contested situation. We draw analogy to the rules of integrity in judicial proceedings. *See, e.g., Davis v. Wakelee*, 156 U.S. 680, 689 (1895) ("[W]here a party assumes a certain position in a legal proceeding, and succeeds in maintaining that position, he may not thereafter, simply because his interests have changed, assume a contrary position, especially if it be to the prejudice of the party

who has acquiesced in the position formerly taken by him."); *cf. U.S. Philips Corp. v. Sears, Roebuck & Co.*, 55 F.3d 592, 596-97, 34 USPQ2d 1699, 1702-03 (Fed. Cir. 1995) (equity holds a party to a position on which it prevailed).

The Board has instructed that Boone's application be examined for the purpose of publication as a SIR. Indeed, Boone has repeated on this appeal that he has no objection to this procedure. In view of Boone's action in requesting conversion to a SIR and the ensuing proceedings, the Board did not err in holidng that Boone is not entitled to a patent on the '541 application. However, the patent interference statute requires the Board to determine which party has prevailed on the issue of priority. 35 U.S.C. § 135(a) ("The Board of Patent Appeals and Interferences shall determine questions of priority . . . .").

Priority issues that have been fully developed and presented for decision should be decided. *See Guinn v. Kopf*, 96 F.3d 1419, 1422, 40 USPQ2d 1157, 1159 (Fed. Cir. 1996). Indeed, the Board did decide priority, for the Board held that Hyatt was not entitled to the benefit of his '881 application date, and confirmed that Boone was entitled to his '565 application date. The Board's reason for refusing to recognize Boone's status as prior inventor was that Boone "was not entitled to a patent by express waiver of that right," citing 35 U.S.C. § 157(a)(3). However, the SIR waiver does not affect the adjudication of priority in resolution of the interference proceeding. The Board's statement, in its reconsideration decision, that it could not adjudge Boone to be prior inventor without also holding that Boone was entitled to a patent, citing 37 C.F.R. § 1.658(a), is an unwarranted reading of the regulation and is unsupported by the statute. Although the Board correctly ruled that Boone was not entitled to a patent, that ruling is not inconsistent with an adjudication of priority. Thus the judgment is modified to state that priority as to the count is awarded to Boone.

SUMMARY

The Board's decision that Hyatt is not entitled to the priority date of the '881 application as to the subject matter of the count is affirmed, as is the Board's decision that Boone is not entitled to a patent on this subject matter. However, judgment of priority in the interference contest shall be entered in favor of Boone.

No costs.

AFFIRMED, MODIFIED IN PART

APPENDIX B

[Filed Jun. 30, 1998]

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

96-1514, 96-1515

HYATT

v.

BOONE

ORDER

UPON CONSIDERATION of Appellant's Motion to Extend Time for Filing Petition for Rehearing and Suggestion for Rehearing En Banc,

IT IS ORDERED that:

The Motion is granted, and the time for filing a Petition for Rehearing and Suggestion for Rehearing En Banc shall be extended fourteen (14) days or to and including July 15, 1998.

FOR THE COURT:

/s/ Jan Horbaly
JAN HORBALY
Clerk

Date: 6/30/98

APPENDIX C

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

96-1514, -1515
(Interference No. 102,598)

GILBERT P. HYATT,
Appellant,

v.

GARY W. BOONE,
Cross-Appellant.

On Appeal from the United States Patent and Trademark Office Board of Patent Appeals and Interferences

In Case No(s). Interference No. 102,598

JUDGMENT

This CAUSE having been heard and considered, it is ORDERED and ADJUDGED: AFFIRMED, MODIFIED IN PART

ENTERED BY ORDER
OF THE COURT

/s/ Jan Horbaly
JAN HORBALY
Clerk

Dated Jun. 17, 1998

APPENDIX D

[Filed Aug. 26, 1998]

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

96-1514, -1515
(Interference No. 102,598)

GILBERT P. HYATT,
Appellant,

v.

GARY W. BOONE,
Cross-Appellant.

ORDER

A combined petition for rehearing and suggestion for rehearing in banc having been filed by the APPELLANT, and a response thereto having been invited by the court and filed by the CROSS-APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the suggestion for rehearing in banc and response having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the suggestion for rehearing in banc be, and the same hereby is, DECLINED.

The mandate of the court will issue on September 2, 1998.

FOR THE COURT

/s/ Jan Horbaly
JAN HORBALY
Clerk

Dated: August 26, 1998

APPENDIX E

Paper No. 263

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

GILBERT P. HYATT,
Junior Party,[1]

v.

GARY W. BOONE,
Senior Party.[2]

Patent Interference No. 102,598

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[1] Patent 4,942,516, granted July 17, 1990, based on Application 07/209,115, filed June 17, 1988. Accorded the benefit of U.S. Application Nos. 06/223, 959, filed January 12, 1981; 05/860,253, filed December 14, 1977; 05/860,256, filed December 14, 1977, now Patent No. 4,829,419, granted May 9, 1989; and 05/860,258, filed December 14, 1977.

[2] Application 07/473,541, filed February 1, 1990. Accorded the benefit of U.S. Application Nos. 07/325,703, filed March 20, 1989; 07/097,489, filed September 15, 1987; 06/915,857, filed October 6, 1986; 06/750,647, filed June 28, 1985; 06/604,404, filed April 27, 1984; 06/002,815, filed January 12, 1979; 05/856,932, filed December 2, 1977, now Patent No. 4,242,675, granted December 30, 1980; 05/420,999, filed December 3, 1973, and 05/163,565, filed July 19, 1971.

FINAL HEARING: March 21, 1995

Before URYNOWICZ, PATE, and LEE, *Administrative Patent Judges.*

PER CURIAM.

Except for the section on *res judicata*/collateral estoppel, Judges Pate and Lee join the entire opinion of Judge Urynowicz. On the issue of *res judicata*/collateral estoppel, Judges Pate and Lee write separately and each concludes that Hyatt should not be estopped from arguing that the disclosure of its U.S. parent application S.N. 101,881 filed December 28, 1970 is enabling with respect to the subject matter of the count.

FINAL DECISION

The invention in issue relates to a computer on a chip. The particular subject matter in issue is defined by the following single count, which is identical to claim 29 of Hyatt, the junior party patentee, and claim 92 of Boone, the senior party applicant.

Count 1

A computer on a chip comprising:

an integrated circuit chip having a computer implemented thereon;

an integrated circuit main memory storing computer instructions, wherein said integrated circuit main memory is included on said integrated circuit chip;

an integrated circuit operand memory storing operands, wherein said integrated circuit operand memory is included on said integrated circuit chip; and

an integrated circuit processing circuit processing the operands stored by said integrated circuit operand memory in response to the instructions stored by said integrated circuit main memory, wherein said processing circuit is included on said integrated circuit chip.

The claims of the parties which correspond to this count are:

Hyatt: Claims 1-3, 6-9, 15, 16, 25-31 and 33-35

Boone: Claims 83-98

This interference was provoked by the party Boone when it copied claims of the involved Hyatt patent into its involved application on January 15, 1991 (Paper No. 16 of the Boone application). The proceeding was declared on March 27, 1991 with counts 1 and 2. At that time, the party Hyatt was accorded benefit with respect to the counts of four prior applications, giving it an effective filing date of December 14, 1977; the party Boone was accorded benefit of a series of nine prior applications, giving it an earlier effective filing date of July 19, 1971. Based on its earlier effective filing date, Boone was accorded senior party status.

Numerous preliminary motions under 37 CFR § 1.633 were filed by the parties in the time set for filing such motions. A *Decision on Preliminary Motions* was rendered April 27, 1992. Of particular interest at final hearing are the following rulings of the Examiner-in-Chief [3] in his decision. Boone's motion under 37 CFR § 1.633(c) to redefine the interfering subject matter by designating Hyatt claims 4, 5, 10-14, 17, 19-24 and 32 as corresponding to count 1 and Hyatt claim 18 as corresponding to count 2 (Paper No. 25) and the senior party's alternative motion in that paper to add claims 99-114 to its involved application and to add sixteen new counts

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[3] The title has since been changed to Administrative Patent Judge (APJ), which will be used hereinafter.

corresponding to each of claims 99-114 and Hyatt claims 4, 5, 10-14, 17-24 and 32, were denied. Boone's motion under 37 CFR § 1.633(c)(1) to redefine the interfering subject matter by substituting count A for count 2 (Paper No. 37) was denied and in a *sua sponte* action of the APJ, count 3, to which Hyatt's claim 35 and Boone's claim 97 correspond exactly, was substituted for count 2. The motion of Hyatt under 37 CFR § 1.663(a) for judgment that all of the Boone claims corresponding to both counts are unpatentable as a result of either: (1) deceptive intention in initially naming Michael J. Cochran as a co-inventor in the Boone application in interference, or (2) deleting Mr. Cochran as a co-inventor at the time of requesting the present interference, and the accompanying request for testimony and to defer the motion to final hearing (Paper No. 14) were denied. The motion of Hyatt under 37 CFR § 1.633(a) for judgment on the grounds that all of Boone's claims corresponding to the counts are unpatentable to Boone under 35 U.S.C. § 112, first paragraph, on the ground that its specification does not provide written description for the full scope of the invention as claimed (Paper No. 15) was denied. The motion of Hyatt under 37 CFR § 1.633(a) for judgment that Boone's claims corresponding to count 1 are unpatentable by reason of double patenting (Paper 16) was granted. The motions of Hyatt under 37 CFR § 1.633(g) to deny party Boone the benefit of the filing dates of its earlier filed applications (Paper No. 17) and under 37 CFR § 1.633(f) to be accorded benefit of the December 28, 1970 and October 1, 1973 filing dates of application Serial Nos. 05/101,881 and 05/402,520, respectively, (Paper No. 12) were denied. The motion of Boone under 37 CFR § 1.633(a) for judgment on the grounds that all of Hyatt's claims corresponding to the counts are unpatentable to Hyatt under 35 U.S.C. §§ 102/103 (Paper No. 23) was granted.

In view of the finding of unpatentability of all claims of the parties Hyatt and Boone which correspond to count

1 and of all claims of Hyatt corresponding to new count 3 in the *Decision on Preliminary Motions*, notice was given pursuant to the provisions of 37 CFR § 1.640(d) that judgment on the record as to those claims would be entered against the parties unless they show cause why such judgment should not be rendered. In response, the parties Hyatt and Boone filed requests for final hearing (Paper Nos. 115 and 116, respectively) to review the matters which were decided in the *Decision on Preliminary Motions*; these requests were granted (Paper No. 133).

Subsequent to the *Decision on Preliminary Motions*, the APJ issued a paper amending that decision (Paper No. 125). In that paper, the APJ moved *sua sponte* to redefine the interfering subject matter by deleting count 3 and by designating those claims of the parties corresponding to count 3 as corresponding to count 1. The interference was redeclared with only count 1 (Paper No. 134).

Both parties submitted evidence in support of their positions at final hearings, filed briefs and appeared for oral argument.[4]

Correspondence of Additional Hyatt Claims

Boone contends that its motion to redefine the interfering subject matter by designating Hyatt claims 4, 5, 10-14, 17-24 and 32 as corresponding claims (Paper No. 25) should not have been denied by the APJ. In the alternative, Boone seeks to add new counts to this interference corresponding to the above claims of Hyatt, which claims Boone has copied into its involved application.

In its brief, Boone takes the position that it has established as required under 37 CFR § 1.637(c)(3)(ii) that

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[4] In the *STATEMENT OF ISSUES* at page 2, items 1-3, of its main brief, *res judicata*/collateral estoppel, enablement under 35 U.S.C. § 112 and written description under 35 U.S.C. § 112 are raised by Hyatt only with respect to its '881 application.

each of the above claims defines the same patentable invention as count 1. In response, Hyatt contends that none of the above claims should be added to this interference. At pages 74-78 of its reply brief, the junior party specifically argues the subject matter of its claims 4 and 5. For the remaining proposed claims, Hyatt simply makes the broad contention that the references cited by Boone to establish that each claim defines the same patentable invention as the count under 37 CFR § 1.637(c)(3)(ii) do not show the claimed features.

Boone argues that dependent claim 4 adds no patentable distinctions to corresponding claim 1 of Hyatt, from which it depends. Purportedly, it merely adds the requirements that the read only memory is arranged to store the computer instructions as eight-bit bytes and that the processing circuit includes a transfer instruction execution circuit including a first accessing circuit accessing three sequential eight-bit bytes stored by said integrated circuit read only memory and a transfer control circuit coupled to the first accessing circuit and transferring control to a next instruction in response to the three eight-bit bytes accessed by said first accessing circuit. The senior party asserts that the requirement that the computer store instructions as eight-bit bytes has already been determined in this interference to be an obvious variation of count 1. In particular, Hyatt claims 2 and 3, which specify that the computer operate with instructions stored as eight-bit bytes, have already been designated as corresponding to count 1.

Boone contends that both storing instructions as eight-bit bytes and the circuitry for executing three byte transfer instructions were well-known features of multi-chip computers by 1970. Boone asserts the book by Yaohan Chu, *Digital Computer Design Fundamentals* (McGraw-Hill Book Company, Inc., 1962), of record (Paper Nos. 152 and 164), discloses a computer with both of these features in Chapter 12, at pages 459-461, in connection

with a configuration for a serial digital computer. The particular example is for a 32-bit word that is transferred in a sequence of four word times or bytes. The word is accessed and read into an instruction circulating register, and an address part of the word is read into an operation-code register. Also, transfer instructions are used to change the program control sequence wherein the contents of the instruction circulating register are transferred to the next instruction circulating register. As can be seen from this example, it was well-known in the art to sequentially access stored eight-bit bytes and execute transfer instructions. The example in Chu is for a sequence of four bytes rather than the claimed three but this is simply a design choice based on the size of the word instruction to be transferred. These aspects of computer design were thus well-known in 1970.

According to Boone, claim 5 of Hyatt is obvious over count 1 for reasons very similar to those concerning claim 4 as discussed above. As to the eight-bit byte limitation, that is merely an obvious embellishment to the count for the same reasons as discussed above in connection with Hyatt claim 4. As to the transfer execution circuit of claim 5, this exact scheme is taught in U.S. Patent 3,400,371 to Amdahl et al., of record (Paper No. 152), for use in a data processing system.

With respect to claim 4, Hyatt contends that: (1) the four byte fixed length instruction format taught by Chu does not suggest the three byte format of the claim; (2) all four bytes of an instruction of the reference are read during the second 32-digit word time and not in four word times as contended by Boone and not in three sequential byte times as set forth in claim 4; and (3) the record is devoid of any evidence as to why it would have been obvious to apply Chu's drum based computer operation to the single chip computer of the count to arrive at the computer defined in claim 4.

Hyatt argues that claim 5 is not rendered obvious by the combination of U.S. Patent 3,400,371 to Amdahl and the count since the Branch on Index High instruction of the patent shown in Fig. 23 has 32 bits, not three bytes as required by claim 5.

We are of the opinion that Hyatt claims 4, 5, 10-14, 17-24 and 32 correspond to count 1.

With respect to claim 4, at pages 459-461, Chu discloses a computer configuration wherein transfer instructions are utilized not only to maintain a program control sequence but also to change the sequence.[5] With respect to Hyatt's arguments, claim 4 is not limited to a three byte format. The recitation of three bytes is met by Chu's four byte format. However, even if claim 4 were limited to a three byte format, this would be obvious over the count and Chu since Chu discloses the use of formats having 2 to 5 bytes at Figs. 12-24 of page 452.

We agree with Hyatt that the Chu text at pages 459-461 discloses that all four bytes of an instruction are read out of memory during the second 32-digit word time and not in four word times as contended by Boone, and certainly not in three sequential byte times. However, claim 4 does not require sequential accessing of three bytes but rather merely recites three sequential bytes. The bytes of an instruction in Chu are sequential as stored in memory as shown at Figs. 12-24 of the Chu text.

The fact that Chu's serial digital computer operation at pages 459-461 is explained utilizing a magnetic-drum memory does not affect the significance of this disclosure. It is clear from these pages of the text that the computer configuration utilizing a magnetic-drum memory is but

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[5] We note that at column 12, lines 15-23, of Hyatt's involved patent, it states that the data processor 12 is organized to operate in a manner similar to known stored program digital computers and that such systems are described in Chu.

one example of a configuration for a serial digital computer. At page 459, Chu states:

> A serial digital computer offers the advantage of using fewer components and circuits, particularly if a sequential memory such as the magnetic-drum memory is used.

Hyatt's sole argument with respect to claim 5 is not persuasive. Corresponding Hyatt claim 2, concerning which Hyatt filed no motion to redefine the interfering subject matter under 37 CFR § 1.633(c) by designating the claim as not corresponding to count 1, defines computer instructions and that at least one of the instructions is an eight-bit byte. Accordingly, this corresponding claim, which by definition defines the same patentable invention as the count (37 CFR § 1.601(f)), teaches plural instructions, each comprising an eight-bit byte. Thus, Hyatt claim 5, which calls for an instruction of three eight-bit bytes, does not define a separate patentable invention from claim 2 or the count.[6]

Furthermore, Hyatt dependent claim 5 is not limited to three bytes. Fig. 23 of the Amdahl patent discloses a 32-bit instruction having four bytes with eight bits/byte which encompasses the three bytes of claim 5. That Fig. 23 consists of four bytes is apparent from a comparison of Figs. 20 and 23, and the description of Fig. 20 at column 23 of the patent indicating that the figure is a scale of the relationship of the byte, half word, word and double word for use with Figs. 20a and 21-26. Thus, the Amdahl patent renders obvious the additional subject matter of dependent claim 5.[7]

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[6] Similarly, Hyatt's argument is not persuasive when considered in light of Hyatt's corresponding claim 3 which recites computer instructions as eight-bit bytes.

[7] It is apparent to us that Amdahl also renders obvious the broader subject matter defined in Hyatt dependent claim 4.

Whereas Hyatt has not specifically opposed Boone's analysis for same patentable invention of claims 10-14, 17-24 and 32 with respect to count 1 made at pages 70-86 of its brief and since we are persuaded by that analysis, we hold that the above claims define the same patentable invention as the count. 37 CFR § 1.637(c)(3)(ii).

Hyatt's Written Description

Hyatt contends that the APJ's finding in the *Decision on Preliminary Motions* that its '881 application fails to meet the written description requirement of 35 U.S.C. § 112, first paragraph, cannot be sustained. According to the junior party, the description of a single chip "data processing system" in original claim 40 of the '881 application including "read only memory means," and "alterable memory means" describes a computer on a chip as defined by the count. Hyatt asserts that the only issue is whether original claim 40 in the context of the '881 application "reasonably conveys to the artisan" a single chip computer including a "processing circuit" as defined by the count.

According to Hyatt, the term "data processing system" used in claim 40 is a system which processes data and which necessarily includes a data processing circuit. Without a processing circuit, no processing could occur in the system on the chip. Allegedly, those skilled in the computer design art agree that claim 40 directs a skilled artisan to place a processor on a single chip. As noted by the junior party at page 41 of its brief, Salzer and Lee, two of Hyatt's witnesses that are computer designers, stated:

> A computer designer of ordinary skill in the art on December 28, 1970, would have recognized the terms "computer," "data processor" and "electronic data processing system" as referring to a computing device that would necessarily have a processing cir-

> cuit. [Salzer, HR 18/1730; Lee similarly at HR 18/1749].

These witnesses further indicated that, as viewed by a skilled computer designer, the term "program means" refers to a circuit that responds to a program, not to a program itself and, thus, refers to the processing circuit.

In opposition, the party Boone states that aforementioned claim 40 does not include on a single chip all the elements required by the count. In particular, claim 40 omits the count's "integrated circuit processing circuit processing the operands stored by said integrated circuit operand memory in response to the instructions stored by said integrated circuit main memory."

Boone asserts that in an effort to cure this deficiency, Hyatt contends that the "processing circuit" processing operands from alterable memory in response to program instructions from main memory can be found in the "program means" of claim 40. However, the common usage of "program means" in the Hyatt specification illustrates the "program" and "program means" are intended to describe only a set of computer instructions or as a modifier to phrases such as "program control means," not a processing circuit operating under control of those instructions. Hyatt used the term "program means" in only one other place in the 1970 application, that being in original claim 70. The claim includes the following paragraph:

> an electronic data processor including memory means, computation means and program means operatively dispersed to monitor said rudimentary, intrinsic input signals at a relatively high data rate, convert said input signals to base data processor signals, interpret said converted signals and generate appropriate system responses.

According to Boone, this claim, which speaks separately of "computation means" and "program means," makes it clear that as used in the 1970 specification the phrase

"program means" does not mean a computation or processing means.

We agree with the APJ and Boone that Hyatt's '881 application fails to meet the written description requirement of 35 U.S.C. § 112, first paragraph, and that Hyatt is not entitled to benefit of either of these prior applications for that reason.

Original claim 40 of the '881 application reads as follows:

> 40. An electronic data processing system including read only memory means, alterable memory means and program means, said system being implemented on a single integrated circuit chip.

The "processing system" of the preamble of claim 40 merely defines what the two memory means and the program means of the body of the claim collectively are intended to define. The preamble does not add a fourth element, i.e., processing circuit, to the three means recited in the claim. Accordingly, if the "integrated circuit processing circuit" of the count is supported in the prior applications, it must be by the recitation of "program means" in claim 40. That it must be by the recitation of "program means" seems to be Hyatt's position herein.

Claim 40 broadly defines two memory means and a "program means" whereas the count specifically defines a main memory storing computer instructions, an operand memory storing operands and a processing circuit processing the operands in response to the instructions. The claim recitations are broad and the read only memory means of claim 40 need not be a main memory storing computer instructions and the alterable memory means need not be an operand memory storing operands. The "program means" of the claim is not a processing circuit nor does the "program means" process operands in response to the stored instructions. As noted by Boone, the use of "program" and "program means" in the Hyatt

specification describes a set of computer instructions and Hyatt's original claim 70 makes it clear that the "program means" is not a processing circuit, as the "computation means" of the claim is the processing circuit. As noted by the APJ in his decision, the disclosure should be clearer than to suggest that one skilled in the art might construct the device in a particular manner. *Bocciarelli v. Huffman*, 232 F.2d 647, 109 USPQ 385 (CCPA 1956); *Brand v. Thomas*, 96 F.2d 301, 37 USPQ 505 (CCPA 1938). The disclosure must be sufficient when considered in its entirety such that the necessary and only reasonable construction to be given the disclosure by one skilled in the art is one which will lend clear support to each positive limitation in the count. *Dyer v. Field*, 386 F.2d 466, 156 USPQ 85 (CCPA 1967).

Testimony of the witnesses Salzer and Lee is not persuasive. They focus on the proposition that a data processing system must generally include a "processing circuit" of some sort without addressing whether a data processing system must necessarily include the specific processing circuit required by the count. The count does not simply recite a processing circuit with no specifically defined functions. Rather, a processing circuit with particularly defined functions is required by the count. While two memories and a computer program may generally constitute a data procesing system of some sort, they do not describe the invention set forth by the count.

Testimony of these witnesses indicating that "program means" refers to a circuit that responds to a program is unpersuasive. It is irrefutable that a program is "program means." Furthermore, if "program means" can be a circuit (processor) that responds to a program as indicated by the above witnesses, it is at least as likely that it can be a memory that merely stores a program without processing operands. The witnesses do not discuss the alternative possibilities. The "program means" as an alleged processing circuit does not have to operate on operands stored in an on-chip memory; the operands may be pro-

vided from elsewhere or, alternatively, there need not be any operands at all. It is not proper to accept affidavits in order to establish facts which the disclosure itself should provide in order to conform to the mandatory provisions of a statute (35 U.S.C. § 112). *In re Smyth*, 189 F.2d 982, 990, 90 USPQ 106, 112 (CCPA 1951).

Patentability of Hyatt's Involved Claims

In the *Decision on Preliminary Motions* (Paper No. 105), the involved claims of Hyatt were found unpatentable under 35 U.S.C. §§ 102/103 on any of the following art or grounds:

1. United Kingdom Patent No. 1,401,265, specification published July 23, 1975, patent sealed November 19, 1975;

2. U.S. Patent No. 3,934,233 issued January 20, 1976, filed September 24, 1973;

3. Texas Instruments Inc. *Programmer Reference Manual for TMS1000 Series MOS/LSI One-Chip Microcomputers* (1975); and

4. the invention was embodied in the following products that were in public use or on sale in the United States prior to December 14, 1976;

a. the TMS0100 series of microcomputer chips;

b. the Texas Instruments SR-10 calculator; and

c. the TMS1000 series of microcomputer chips.

Since the junior party does not argue the impropriety of the APJ's holding of unpatentability of its corresponding claims under 35 U.S.C. §§ 102/103 as aforementioned, since we held above that Hyatt is not entitled to benefit of the '881 application, and since we are aware of no reason why the holding of unpatentability of Hyatt's involved claims should be withdrawn, we sustain that holding. With respect to the claims of Hyatt newly added

as corresponding to the count, Hyatt has chosen not to argue their separate patentability over the prior art, even though the issue of their correspondence to the count was raised during the preliminary motions period. Accordingly, they fall with Hyatt's claims 1-3, 6-9, 15, 16, 25-31 and 33-35. *Cf. In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

We also sustain the holding of the APJ in his *Decision on Preliminary Motions* that all of Hyatt's corresponding claims are unpatentable to the junior party on the basis of its admission at page 2 of its opposition paper filed July 22, 1991 (Paper No. 47) that some of the art cited in the record of his involved patent would preclude patentability based on a 1977 effective filing date.

Hyatt's Conception

Boone contends at pages 32-35 of its brief that Hyatt's claims are unpatentable because of lack of conception. According to the senior party's brief at page 33, the general goal of placing all parts of a computer on a single chip was well-known before Hyatt entered the field. At pages 17 and 18 of its brief, Boone refers to four papers published prior to the November, 1967 date of conception alleged by Hyatt in its preliminary statement in support of this contention. Boone takes the position that since the inventor Hyatt testified on page 4 in his July 17, 1991 declaration that:

> I am not now and I have never been a chip designer or an integrated circuit processing person . . . . My plan had always been to take my single chip computer design to a company that built custom integrated circuits and let that company build my computer using one of their standard processes selected by them[,] . . . .

he did not know how to put all of the components of a computer on a single chip and never had a complete conception of a single chip computer.

In opposition, Hyatt contends to the effect that the senior party is not now entitled to raise the issue of the junior party's conception since priority of invention is not at issue at this time in the proceeding. The junior party also contends at page 48 of its brief that Boone's conception argument fails on the merits since:

> [w]hen *all* of the testimony is considered, it becomes clear that Hyatt (i) had a general knowledge of integrated circuit design and processing sufficient to conceive a single chip data processor, (ii) had a complete single chip data processor design that had been built in multi-chip form and disclosed that design in *inter alia* the '881 application, and (iii) relied on integrated circuit companies to manufacture his design using their standard integrated circuit processes and techniques. Hyatt merely relied on those skilled in the art of chip design and processing to use what was well known in the art to place his working design on a single chip (footnote omitted).

We agree with Hyatt that it is premature for Boone to raise the issue of conception by Hyatt at this stage of the proceeding. Testimony with respect to priority of invention has not been taken in this case as this case was set down for final hearing to review only matters addressed in the *Decision on Preliminary Motions.* See Paper No. 133.

Although we have ruled that it is not timely to consider conception by the junior party Hyatt at this time, as an aside, we make the following observation with respect to the patentability of its corresponding claims based on argument made by Boone charging that Hyatt did not conceive the invention. Recognizing that Hyatt admits to the effect that he did not have in mind a process or technique for building a single chip computer and assuming for purposes of argumentation Hyatt's position in this proceeding that in 1970, one of ordinary skill in the art of chip design would have been able to make the invention

described in the '881 application defined by the count, we are of the opinion that Hyatt's claims corresponding to the count are unpatentable over the prior art cited by Boone at pages 17 and 18 of its brief, and further noted by the senior party at page 33 of the brief. This art refers to putting a computer on a single chip [8] and it became applicable against Hyatt when it became enabled by late 1970 by one other than Hyatt skilled in the art to which the invention pertains. Before a publication can be used to reject an application, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. *Cf. In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). Thus, even assuming we had reached a decision on the merits on the issue of enablement and held that Hyatt proved its position that in 1970 those skilled in the art of chip design were able to build a computer on a single chip and Hyatt's '881 application was otherwise in compliance with 35 U.S.C. § 112, first paragraph, judgment would have been awarded against Hyatt on the basis that its corresponding claims are not patentable to it over the prior art. If the actual prior art reference anticipates the subject matter of the count, as here, all claims that have been designated as corresponding to that count would be unpatentable for anticipation or obviousness. *In re Van Geuns, supra.*

In accord with the above assumption regarding enablement, since the idea of placing the parts of a basic computer on a single chip was known prior to Hyatt's earliest alleged fact with respect to the invention in its preliminary statement (November, 1967) and since the junior party relies on one skilled in the art in 1970 to enable its own

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[8] According to Hyatt's main brief at pages 8-12, a computer includes a main memory storing instructions (item a., pages 9 and 10), a second memory storing operands (item b., pages 10 and 11) and a processing circuit processing operands stored in the second memory in response to instructions stored in the main memory.

subsequent idea of placing a computer on a chip, it would not have been possible for Hyatt to successfully make oath or declaration under 37 CFR § 1.131 showing completion of the invention before the date of enablement of the aforementioned prior art cited by Boone.

Boone's Request for a Statutory Invention Registration

In its brief at final hearing, the senior party states that, in pursuing this interference, it is not the goal of Boone and Texas Instruments to obtain an enforceable patent covering the fundamental invention of a single-chip computer. Accordingly, Boone renews a prior request that the Board consent to the entry of a letter requesting a Statutory Invention Registration (SIR) under 35 U.S.C. § 157 for its involved application.

We are aware of no reason why Boone's request should not be considered favorably and, accordingly, grant the request to the extent that Boone's application will be remanded to the primary examiner for examination as a SIR application upon termination of this proceeding.

The parties to an interference are presumed to have made their inventions in the chronological order of their effective filing dates. 37 CFR § 1.657(a). Since Boone has the earlier effective filing date in this case, that presumption applies to party Boone, who is accordingly considered to be the prior inventor of the subject matter in issue. However, favorable judgment is normally rendered in an interference only with respect to parties which are patentees, or with respect to applicants whose goal it is to obtain a patent. Since Boone's request for a SIR application makes it evident that it is not such an applicant and that it is not entitled to a patent by express waiver of that right in its involved application (35 U.S.C. § 157 (a)(3)), judgment will not be entered in Boone's favor.

Since our findings above are dispositive of this interference with respect to Hyatt, except for the issue of *res*

judicata/collateral estoppel discussed below, we do not reach other issues raised by the parties for decision at final hearing with respect to the junior party. In view of the foregoing decision concerning the Boone application, we need not reach the issues raised by Hyatt with respect to the senior party.

Hyatt's Motion for Benefit of Serial No. 05/101,881—Res Judicata/Collateral Estoppel

URYNOWICZ, Administrative Patent Judge.

The junior party contends that it is not bound by the adverse *ex parte* decision of June 9, 1988 of the U.S. Court of Appeals for the Federal Circuit (*In re Hyatt*, No. 87-1597 (Fed. Cir. June 9, 1988) (non-precedential)) in its prior application S.N. 05/860,253 filed December 14, 1977 (the '253 application) from obtaining benefit as to the count of prior application Serial No. 05/101,881 filed December 28, 1970 (the '881 application).[9] In that decision, the Federal Circuit affirmed the decision of the Board sustaining the rejection of all claims of the '253 application as not patentable under 35 U.S.C. § 112, first paragraph, since, with respect to the date of the '881 application:

> [a]ppellant has not come close to presenting sufficient evidence to make a persuasive case that a routineer in the integrated circuit art in 1970, presented with appellant's disclosure and supplementing it with what was well known in the art, could have implemented appellant's computer on a single chip without undue experimentation.

Page 9 of the court's opinion.

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[9] The '253 application is a continuation-in-part of the '881 application. Inspection of the files reveals that appealed claims 1 and 45 of the '253 application and count 1 of this interference broadly define a computer on a chip and are of the same scope. The claims and count 1 are essentially the same.

According to Hyatt, *ex parte* prosecution cannot be properly characterized as either a dispute or litigation. *In re Craig*, 411 F.2d 1333, 1335-36, 162 USPQ 157, 159 (CCPA 1969) and, the use of *res judicata* in continuing patent applications after an *ex parte* appeal has been materially restricted. *In re Herr*, 377 F.2d 610, 611, 153 USPQ 548, 549 (CCPA 1967). Hyatt contends that the aforementioned decisions are controlling and that as an applicant in S.N. 209,115 (the '115 application) submitting new evidence and/or claims, it was not bound by a prior adverse decision in its parent '253 application by the Board of Patent Appeals and Interferences or the Federal Circuit.[10] *Herr, supra*, 377 F.2d at 611, 153 USPQ at 549, *Craig, supra*. Also, *In re Russell*, 439 F.2d 1228, 169 USPQ 426 (CCPA 1971), and *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985).

The senior party Boone avers that Hyatt is bound under principles of *res judicata*/collateral estoppel by the Federal Circuit's prior determination to the effect that Hyatt's '253 and '881 applications are not enabling with respect to a computer on a chip. Furthermore, at page 11 of its brief, Boone draws attention to the fact that, in prosecuting the application that matured into the '516 patent, Hyatt argued that the Federal Circuit decision "can now be considered to be 'law of the case' herein and this can be considered to be res judicata herein."

Boone states that Hyatt misreads *Herr, supra*, and that a correct reading of the case indicates that the junior party patentee should be bound by the aforementioned 1988 Federal Circuit decision. Boone brief, page 11. According to the senior party, *Herr, supra*, presented the issue of whether an applicant whose claims in a parent application had previously been rejected over prior art and then had that rejection affirmed by an appellate court, was bound in his continuing application to the results of

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[10] The '115 application matured into involved Hyatt U.S. Patent 4,942,516 (the '516 patent).

that affirmance by prinicples of *res judicata*/collateral estoppel. While the court concluded in a 3-2 split decision that these principles did not apply to the facts in that case involving a rejection of claims in a parent application over prior art, it did not erect any sweeping rule that decisions on appeal from *ex parte* rejections of claims have no *res judicata*/collateral estoppel effect.

Boone cites the language of Judge Rich in his concurring opinion at 377 F.2d at 619, 153 USPQ at 555 of the *Herr, supra*, decision that:

> Where an appellate court has decided a *specific* question, for example that the disclosure of an application is inoperative as in Hemphill v. Coe and *In re Lawson*, or that claims are not supported by the disclosure of an application within the meaning of 35 U.S.C. § 112, . . . the doctrine of collateral estoppel should normally prevent relitigation of that issue.[11]

The senior party notes that the court in *California Computer Products, Inc. v. Simplicity Pattern Co.*, 194 USPQ 367, 370 (C.D. Cal. 1977), applied Judge Rich's above analysis to a case involving a continuation where the parent had previously been held by the Court of Customs and Patent Appeals to have an inadequate disclosure under 35 U.S.C. § 112.

It is considered that Hyatt is bound by the decision of the Federal Circuit in *Hyatt, supra*, dated June 9, 1988 in its parent '253 application and, thus, that Hyatt is not entitled to benefit of the '881 application in this proceeding on the basis of *res judicata*/collateral estoppel. To serve as a constructive reduction to practice, the disclosure of the subject matter of the count must meet the requirements of 35 U.S.C. § 112, first paragraph. *Bigham v. Godtfredsen*, 857 F.2d 1415, 8 USPQ2d 1266 (Fed. Cir. 1988).

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[11] *Hemphill Co. v. Coe*, 121 F.2d 897, 49 USPQ 484 (D.C. Cir. 1941); *In re Lawson*, 70 F.2d 373, 21 USPQ 390 (CCPA 1934).

Hyatt misconstrues *Herr, supra.* In his concurring opinion in that case, Judge Rich indicated that in the administrative process of patent granting, including appellate review of rejections, estoppel by prior judgment should be applied only in the clearest cases of attempted reargument of previously decided issues. He further indicated to the effect that *res judicata* was devised in connection with the litigation of disputes, not with respect to the application for government grant of statutory rights dependent for issuance on compliance with stated conditions. The concuring opinion made an important distinction, stating to the effect that there is an essential difference between *ex parte* and *inter partes* cases with respect to *res judicata* in the U.S. Patent and Trademark Office (PTO). However, with respect to *ex parte* appeals Judge Rich asserted that where an appellate court has decided a specific question such as that the disclosure of an application for patent is inoperative as in *Hemphill, supra* and *Lawson, supra,* the doctrine of collateral estoppel should normally prevent relitigation of that issue.

Hemphill, supra, was first adjudicated in the Court of Customs and Patent Appeals (CCPA) as *Lawson, supra,* one holding of the court being that the disclosure in the parent application was inoperative. A second application was filed but was subject to an intervening bar by public use unless the filing date of the parent was available. In considering the new rejection of the second application on the public use bar, the Court of Appeals for the District of Columbia refused to reconsider the specific question of inoperativeness which had been decided by the CCPA, a question which related to the identical application on which the CCPA had ruled. In effect, its decision was to accept as final the decision of the CCPA on the inadequacy of the parent application as a disclosure.

While a party such as Hyatt against whom a plea of preclusion is asserted must have been a party to the prior proceeding, a party such as Boone asserting the plea need

not have been. *Blonder-Tongue Lab., Inc. v. Univ. of Ill. Found.*, 402 U.S. 313, 169 USPQ 513 (1971). Here, we have an *inter partes* case involving a dispute. Like *Hemphill, supra*, and *In re Szwarc*, 319 F.2d 277, 138 USPQ 208 (CCPA 1963), a specific question involving the adequacy of disclosure of an application for patent has been decided by a court of appeals in the negative. Thus, like the Court of Appeals for the District of Columbia in *Hemphill* and the Court of Customs and Patent appeals in *Szwarc*, the Board should refuse to reconsider the question of adequacy of disclosure which has been decided by an appeals court. Hyatt had a fair opportunity procedurally, substantively and evidentially to pursue his claim of enablement during the pendency of the '253 application. *Blonder-Tongue, supra.* Having failed to so pursue his claim, the junior party should not be allowed to now renew its claim to the detriment of others such as Boone.

The cases cited by Hyatt in support of its position are distinguishable and are not controlling. Those cases, *Donohue, supra, Russell, supra, Craig, supra*, and *Herr, supra,* did not involve a dispute between parties such as we have in the present proceeding, but were simply *ex parte* cases having new records and involving the application for government grant of statutory rights dependent for issuance on compliance with stated conditions. The party Hyatt failed to put its best foot forward in the '253 applicaiton to its own peril and should not now be allowed to stomp on the intervening rights of another such as Boone in view of that failure. Furthermore, the above cases did not involve the decision of a specific question under 35 U.S.C. § 112, such as whether the disclosure of an application is inoperative, as in *Hemphill, supra* and *Lawson, supra* or whether claims are supported by the disclosure of an application as in *Szwarc, supra* or whether a disclosure is enabling as in *Hyatt, supra.*

PATE, *Administrative Patent Judge.*

I write separately, on the issue of collateral estoppel/*res judicata*. The issue, as I understand it, is much simpler than has been outlined by my fellow panel members.

In his concurring opinion in *In re Herr*, 377 F.2d 610, 619, 153 USPQ 548, 555 (CCPA 1967) Judge Rich expressly addresses this precise situation when he states,

> Where an appellate court has decided a *specific* question, for example that the disclosure of an application is inoperative *or that claims are not supported by the disclosure of an application within the meaning of 35 U.S.C. § 112*, the doctrine of collateral estoppel should normally prevent relitigation of that issue (citations omitted; second emphasis supplied).

However, Judge Rich then continues stating,

> The broader all-inclusive issue of patentability of claims, however, depends on numerous factors which may be found in the *words of the claims themselves*, in the disclosure of the specification, in extraneous evidence, in factor relating to the admissibility of evidence and possibly elsewhere (emphasis supplied).

Thus, while the specific issue of 35 U.S.C. § 112 first paragraph support has been decided by the Federal Circuit, the claims of party Hyatt are not now literally the same as the claims on appeal in the decided case. For this simple reason, it is my view that estoppel should not apply in this instance.

LEE, *Administrative Patent Judge.*

I agree with Judge Urynowitz's opinion in full, except for its conclusion and discussions in the section applying *res judicata*/collateral estoppel against Hyatt to preclude Hyatt from arguing enablement with respect to his priority application.

In my view, Hyatt is not estopped from arguing that the specification of his earlier '881 application is enabling with respect to an embodiment within the count. However, the merits of the enablement issue need not be reached because the specification of the '881 priority application clearly lacks adequate written description for an embodiment within the count.

Judge Rich's concurring opinion in *In re Herr*, 377 F.2d 610, 619, 153 USPQ 548, 555 (CCPA 1967) is not fully understood insofar as its distinguishes "[t]he broader, all inclusive issue of patentability of claims" from "a *specific* question" on whether a disclosure is inoperative or whether the claims are unsupported by the disclosure within the meaning of 35 U.S.C. § 112, first paragraph. The former, according to Judge Rich, depends on numerous factors which may be found in the words of the claims themselves, in the disclosures of the specification, in extraneous evidence, and in factors relating to the admissibility of evidence. But I see the inadequate written description issue also as involving all-inclusive questions which may turn on many underlying factors including changes to the claims and the substance and admissibility of extrinsic evidence.

If the claims are amended, that will certainly affect the determination on the adequacy of written description support in the specification. The same is true if declarations from experts or people of ordinary skill in the art are submitted and considered. A different body of extrinsic evidence establishes a different evidentiary record. Moreover, if claim language is alternatively interpreted, that will also affect any analysis on the adequacy of written descriptive support in the specification. We know that claim interpretation depends on a multitude of different factors including extrinsic evidence such as expert testimony. *Hormone Research Foundation, Inc. v. Genentech, Inc.*, 904 F.2d 1558, 1562, 15 USPQ2d 1039, 1043 (Fed. Cir. 1990), *cert. dismissed*, 499 U.S. 955 (1991). If written

description is a "specific question," I see no reason why patentability over prior art is not, and if patentability over prior art is not a "specific question," I see no reason why written description is.

In contrast, what is crystal clear from Judge Rich's concurring opinion in *In re Herr*, *supra*, is that there are important policy reasons for allowing an applicant attempting to secure the issuance of a patent to come back with new evidence in continuing applications to try to meet the requirements law.

In *In re Herr*, 377 F.2d 615-16, 153 USPQ at 552-53, Judge Rich stated:

> Res judicata is a judicial doctrine the purpose of which is to settle *disputes* and put an end to *litigation*, enforcing ultimate repose. This is a matter of public policy, and a good one when applied to the situations for which it was designed. But the ex parte prosecution of patent applications cannot properly be characterized as either dispute or litigation. Moreover, there is another public interest to be considered, inherent in the patent laws, which is to bring *patentable* inventions into the open through *granting* patents on them . . . .
>
> . . . .
>
> . . . Allowing and entertaining an application must be distinguished [from repeated litigation of the same issues]. The Patent Office has to entertain every application. Allowance depends on compliance with the statutory prerequisites. The second application may comply whereas the first did not. If I apply for a driver's license, I have to pass eye and driving tests. I may fail. If I come back with glasses and the requisite skill, should my new application be entertained and allowed? Or am I forever barred because I appealed the first denial? Yes, there is every reason why the first determination should not

> be conclusive. The applicant may be bringing the required statutory quid pro quo which he did not bring before. Why not ten or twenty? To be realistic, why not two or three? Is this not authorized practice? The applications will stop when the application offers nothing new and the applicant is merely repeating himself, whereupon the Office will be justified in merely denying them *for the same reasons as previously stated.* No applicant will keep this up very long (emphasis in original).

Judge Rich's concurring opinion in *In re Herr*, 377 F.2d at 619, 153 USPQ at 555, concludes with this statement:

> In the administrative process of patent granting, including appellate review of rejections, *estoppel by prior judgment should be applied only in the clearest cases of attempted reargument of previously decided issues* (emphasis added).

Even in *In re Herr*, *supra*, the CCPA held that collateral estoppel did not apply in the factual circumstances there.

I see no proper basis for singling out 35 U.S.C. § 112, first paragraph, issues as those for which *res judicata* and collateral estoppel principles will automatically successfully preclude a revisiting of the issues on the basis of a different evidentiary record.

Hyatt's submission in this interference of substantial extrinsic evidence not previously presented before the Patent and Trademark Office more than amply demonstrates that this is not one of those "clear cases" of mere reargument referred to by Judge Rich in *In re Herr*, *supra*. The "reargument" contemplated by Judge Rich means a state of affairs wherein the applicant offers up nothing meaningfully new in the evidence to be considered by the Patent and Trademark Office.

Note also that in Hyatt's involved application, the Primary Examiner rejected all of Hyatt claims on the ground that the disclosure did not enable the making of a com-

puter on a single chip (Office Action dated July 12, 1989). In response to the rejection, Hyatt submitted arguments as well as his own affidavit (Paper No. 10 in Hyatt's involved patent) as evidence that the disclosure was enabling at the time of filing of the '881 application based on the knowledge of one with ordinary skill in the art in November 1970. Thereafter, the examiner withdrew outstanding rejections and allowed all of Hyatt's claims.

Thus, during prosecution of Hyatt's involved patent and upon allowance of his claims, Hyatt had no further need to provide additional extrinsic evidence of the type he is presenting now. Had the examiner not allowed Hyatt's claims, Hyatt may well have previously presented in *ex parte* prosecution the evidence now he seeks to present. It was the PTO who made it unnecessary for Hyatt to present additional evidence during examination.

The Court of Customs and Patent Appeals has held that *res judicata* does not have its usual impact when considering *ex parte* appeals and that the public interest in granting valid patents outweighs the public interest underlying collateral estoppel and *res judicata*. *See, e.g., In re Oelrich*, 666 F.2d 578, 580 n.2, 212 USPQ 323, 325 n.2 (CCPA 1981). While this case is an *inter parte* interference, it is the *ex parte* or *inter parte* nature of the prior decision on the basis of which a later argument would be estopped which matters. *See, e.g., In re Clark*, 522 F.2d 623, 187 USPQ 209 (CCPA 1975); *In re Pritchard*, 463 F.2d 1359, 175 USPQ 17 (CCPA 1972); *In re Katz*, 467 F.2d 939, 167 USPQ 487 (CCPA 1970).

The CCPA decisions in *In re Donohoe*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985), *In re Russell*, 439 F.2d 1228, 169 USPQ 426 (CCPA 1971), and *In re Craig*, 411 F.2d 1333, 162 USPQ 157 (CCPA 1969), which all held that estoppel did not apply, cannot be distinguished on the basis that they involve an *ex parte* situation whereas this case does not. Just as in those cases,

the prior decision involved here is an *ex parte* decision in the course of patent examination.

Judgment

Judgment as to the subject matter of count 1 is hereby awarded against Gilbert P. Hyatt, the junior party. The party Hyatt is not entitled to its involved patent with claims 1-35.

Judgment as to the subject matter of count 1 is hereby awarded against Gary W. Boone, the senior party. The party Boone is not entitled to a patent with its claims 83-98.

/s/ Stanley M. Urynowicz, Jr.
STANLEY M. URYNOWICZ, JR.
Administrative Patent Judge

/s/ William F. Pate, III
WILLIAM F. PATE, III
Administrative Patent Judge

/s/ Jameson Lee
JAMESON LEE
Administrative Patent Judge

BOARD OF PATENT APPEALS
AND INTERFERENCES

[DoC Logo] Paper No. 23

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Patentee Hyatt

Serial No. 07/209,115

Filed 06/17/88, now Patent No. 4,942,516, granted 07/17/90

FOR: SINGLE CHIP INTEGRATED CIRCUIT COMPUTER ARCHITECTURE

Accorded Benefit of: U.S. Application Nos. 06/223,959, filed 01/12/81; 05/860,253, filed 12/14/77; 05/860,-256, filed 12/14/77, now Patent No. 4,829,419, granted 05/09/89; and 05/860,258, filed 12/14/77

REDECLARATION

In view of the Board decision of even date herewith, this proceeding is redeclared by adding Hyatt claims 4, 5, 10-14, 17-24 and 32 as corresponding claims. The claims of the parties which correspond to count 1 are:

Hyatt Claims 1-35
Boone Claims 83-98

/s/ Stanley M. Urynowicz, Jr.
STANLEY M. URYNOWICZ, JR.
Administrative Patent Judge
(703) 603-3312

[DoC Logo] Paper No. 27

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Applicant Boone

Serial No. 07/473,541

Filed 02/01/90

FOR: VARIABLE FUNCTION PROGRAMMED SYSTEM

Accorded Benefit of: U.S. Application Nos. 07/325,703, filed 03/20/89; 07/097,489, filed 09/15/87; 06/915,-857, filed 10/06/86; 06/750,647, filed 06/28/85; 06/604,404, filed 04/27/84; 06/002,815, filed 01/12/79; 05/856,932, filed 12/02/77, now Patent No. 4,242,675, granted 12/30/80; 05/420,999, filed 12/03/73; and 05/163,565, filed 07/19/71

REDECLARATION

In view of the Board decision of even date herewith, this proceeding is redeclared by adding Hyatt claims 4, 5, 10-14, 17-24 and 32 as corresponding claims. The claims of the parties which correspond to count 1 are:

Hyatt Claims 1-35

Boone Claims 83-98

/s/ Stanley M. Urynowicz, Jr.
STANLEY M. URYNOWICZ, JR.
Administrative Patent Judge
(703) 603-3312

APPENDIX F

Paper No. 271

UNITED STATES PATENT
AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

GILBERT P. HYATT
Junior Party,[1]

v.

GARY W. BOONE
Senior Party.[2]

Interference No. 102,598

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[1] Patent No. 4,942,516, granted July 17, 1990, based on Application 07/209,115, filed June 17, 1988. Accorded the benefit of U.S. Applications 06/223,959 filed January 12, 1981, 05/860,253 filed December 14, 1977, 05/860,256 filed December 14, 1977, now Patent No. 4,829,419 granted May 9, 1989 and 05/860,258 filed December 14, 1977.

[2] Application 07/473,541, filed February 1, 1990. Accorded the benefit of U.S. Applications 07/325,703 filed March 20, 1989, 07/097,489 filed September 15, 1987, 06/915,857 filed October 6, 1986, 06/750,647 filed June 28, 1985, 06/604,404 filed April 27, 1984, 06/002,815 filed January 12, 1979, 05/856,932 filed December 2, 1977, now Patent No. 4,242,675 granted December 30, 1980, 05/420,999 filed December 3, 1973 and 05/163,565 filed July 19, 1971.

Before URYNOWICZ, PATE and LEE, *Administrative Patent Judges.*

URYNOWICZ, *Administrative Patent Judge.*

RECONSIDERATION

The party Boone has filed a request for reconsideration under 37 CFR §1.658(b) (Paper No. 267) of our decision at final hearing of September 19, 1995 (Paper No. 263). The party Hyatt stands opposed (Paper No. 269).

Boone contends that the form of the judgment should be revised to reflect the Board's conclusions as stated in the opinion portion of the decision at final hearing. The senior party argues to the effect that judgment against Boone should be vacated and requests that the form of the judgment as to it be changed to read as follows:

> Priority as to the subject matter of count 1 is hereby awarded to Gary W. Boone, the senior party. Because the party Boone's application will be examined only as a SIR application, no judgment is awarded as to the patentability of Boone's involved claims.[3]

It is alleged that without a statement in the judgment awarding priority in Boone's favor, the *ex parte* examiner handling Boone's application will not have clear and authoritative guidance establishing that the statutory requirement of a final determination of priority has been met.

We find no merit to the argument of Boone. With respect to the last contention above, 37 CFR §1.658(a) merely provides that in a decision entering judgment as to a count, the judgment shall state whether or not each party is entitled to a patent containing the claims in the party's patent or application which corresponds to the

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[3] SIR is an abbreviation for Statutory Invention Registration.

count. The rule does not require a judgment to state that priority of invention as to the subject matter of a count is awarded to a party where the Board found priority of invention as to that party in the opinion portion of its decision.

In its opinion, the Board did in fact state to the effect that as between Hyatt and Boone, Boone is the prior inventor. That statement appears as the first two sentences of the paragraph bridging pages 23 and 24 of our decision. We reiterate that Boone is presumed to be the prior inventor of the subject matter in issue.

As noted above, 37 CFR §1.658(a) provides that a judgment as to a count shall state whether or not each party is entitled to a patent containing the claims in the party's patent or application which correspond to the count. Whereas Boone has elected to obtain a SIR, it was proper under the rule to indicate in our judgment that Boone is not entitled to a patent with its claims 83-98. The only other possibility was for the Board to state in the judgment that Boone is entitled to a patent with its claims 83-98. Having elected a SIR, Boone is not so entitled.

Since Boone is not entitled to a patent with its involved claims, it logically follows that judgment be entered against, as opposed to for, Boone.

The request for reconsideration is granted to the extent of our above reconsideration but is denied as to making any change in our final decision.

/s/ Stanley M. Urynowicz, Jr.
STANLEY M. URYNOWICZ, JR.
Administrative Patent Judge

/s/ William F. Pate, III
WILLIAM F. PATE, III
Administrative Patent Judge

/s/ Jameson Lee
JAMESON LEE
Administrative Patent Judge

BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 272

UNITED STATES PATENT
AND TRADEMARK OFFICE

BEFORE THE COMMISSIONERS OF PATENTS
AND TRADEMARKS

GILBERT P. HYATT
Junior Party,

v.

GARY W. BOONE
Senior Party.

Interference No. 102,598

DECISION ON PETITION

Boone petitions (Paper No. 266) seeking to invoke the supervisory authority of the Commissioner "over the procedures to be followed in patent interferences involving applications for statutory invention registration (SIRs)."

Upon review of the petition, what Boone actually seeks is review of the judgment of the Board. Alternatively, the relief sought by Boone is a rehearing. However, review of a judgment of a the Board is by way of appeal (35 U.S.C. § 141) or civil action (35 U.S.C. § 146). Furthermore, only the Board is authorized to grant a rehearing. 35 U.S.C. § 7(b), last sentence. Hence, a petition cannot be used as a vehicle for seeking an amendment of the Board's judgment or as a vehicle for a petition for rehearing.

The interference involves a patent of Hyatt and a patent application of Boone. At some point during the pendency of the Boone application, Boone indicated that it was his intention to convert the Boone application into a SIR.

If an interference is declared with respect to an application sought to be converted into a SIR, a SIR may not be published unless the issue of priority of invention is finally determined in favor of the applicant. 35 U.S.C. § 157(a), last sentence.

In entering judgment in this interference, the panel determined that Hyatt was not entitled to a patent because the claims of the Hyatt patent were not patentable. The panel also determined that Boone was not entitled to a patent, because of Boone's explicit desire to have the application published as a SIR. Hence, judgment was entered against both parties, that is, the panel determined that neither party was entitled to a patent containing claims corresponding to the count. However, on the issue of priority of invention, the panel made it absolutely clear in its opinion in support of its original decision (Paper No. 263, page 23) that Boone is "considered to be the prior inventor of the subject matter in issue," i.e., the subject matter of the count. At the time the interference was declared, a presumption existed that Boone was the prior inventor vis-a-vis Hyatt, because Boone was designated as the senior party. 37 CFR § 1.657(a). Nothing which happened during the interference changed the presumption. *Compare Oka v. Youssefyeh,* 849 F.2d 581, 584, 7 USPQ2d 1169, 1172, col. 1, last paragraph (Fed. Cir. 1988).

In light of the discussion above, it is manifest that the panel has determined the issue of priority of invention in favor of Boone. Hence, there is nothing in the last sentence of 35 U.S.C. § 157(a) which precludes publication of the Boone application involved in the interference as a SIR.

The petition is *denied.*

/s/ Bruce H. Stoner, Jr.
BRUCE H. STONER, JR.
Chief Administrative Patent Judge